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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/022,132	02/11/1998	JOHANNES F.M. D'ACHARD	PHN-16.219	5325

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
WHITE, CARMEN D	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 08/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/022,132	Applicant(s) D'ACHARD, JOHANNES F.M.
	Examiner Carmen D. White	Art Unit 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/21/03 (as well as the Board's Decision)*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 6-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Response to Board Decision

This following office action is in response to the board decision rendered on November 21, 2002 and Applicant's amendment filed on January 21, 2003.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 6-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation "wherein the image of the currently high scoring player is displayed in a more prominent location than the images of others of the multiple players during the particular session of the video game" is not found to be properly enabled by the instant disclosure.

The examiner has not been able to find a clear teaching of this feature in the specification. Figure 2 of the instant invention teaches away from this feature. Fig. 2 shows the display of images of 2 players (#72 and #74). Neither image appears to be any more prominent than the other. Page 4 of the instant specification describes Fig. 2, but does not provide any clear teaching of this newly added feature.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick in view of Breslow.

Regarding claims 1-4 and 6-8, Sitrick and Breslow teach the elements of the claims as explained in the Final rejection of paper #18, as well as the Examiner's Answer of paper #23, both incorporated herein by reference.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick in view of Breslow, further in view of Hogan or Weiss.

Regarding claim 9, Sitrick and Breslow teach the elements of the claim as explained in the Final rejection of paper #18, as well as the Examiner's Answer of paper #23, both incorporated herein by reference.

As suggested by the Board, the rationale for combining both Sitrick and Breslow to meet the limitations of the instant claims has been changed (since the Final Rejection, paper #18) and is as follows (excerpt taken from pages 7-8 of the Board's decision):

> [T]he combined teachings of Sitrick and Breslow do support a conclusion that the subject matter set forth in claims 1 and 6 would have been obvious within the meaning of 103(a). Sitrick and Breslow collectively describe the use of a player's visual image to represent the player within the presentation of a game as an interactive enhancement feature which makes the game more personal and exciting. The teaching of these benefits would have provided the artisan with ample suggestion or motivation to utilize the visual images of the players in Sitrick's multiplayer game as, for example, playing objects controlled by the

respective players. This incorporation of the players' video images into the game would necessarily result in the backfeed and display of the video image of the "currently high-scoring player," whomever that might be, within the gaming environment in a prominent location during the particular session of the game, and thus responds to the "currently high-scoring player limitations recited in claims 1 and 6.

Further, since dependent claims 2-4 and 7-9 stand or fall therewith, this rejection and rationale stands for these claims as well.

The newly amended claim features of claims 1-4 and 6-9 are not properly enabled (see above claim rejections). Therefore, Sitrick, Breslow and Hogan or Weiss meet the claim limitations of the instant claims as discussed above.

Regarding newly added claims 10-14, the limitations recited in these claims have been addressed in the above claim rejections. The limitations of claims 10-12 and 14 are taught by Sitrick and Breslow. Reference to these limitations are indicated in this action, as well as prior office actions. The limitations of claim 13 are taught by Sitrick and Breslow, further in view of Hogan or Weiss. The only new feature of the instant claims that has not been addressed by the examiner in previous office actions is found in lines 9-11 of the claim, which recite "wherein the image of the currently high scoring player is displayed in a more prominent location than the images of others of the multiple players." This limitation is not properly enabled (see above claim rejections). Therefore, Sitrick, Breslow and Hogan or Weiss meet the claim limitations of the instant claims as discussed above.

Examiner's Response to Applicant's Remarks

Applicant argues the newly amended claim features. However, as indicated above, these features are not clearly enabled.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for unofficial communications and 703-305-3579 for official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

cdw

S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700